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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,923	03/01/2004	Nancy C. Frye	063293.0110	1435
5073	7590	10/08/2008	EXAMINER	
BAKER BOTTS L.L.P.			PATTERSON, MARIE D	
2001 ROSS AVENUE				
SUITE 600				
DALLAS, TX 75201-2980				
			ART UNIT	PAPER NUMBER
			3728	
			NOTIFICATION DATE	DELIVERY MODE
			10/08/2008	ELECTRONIC

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/790,923  
Filing Date: March 01, 2004  
Appellant(s): FRYE, NANCY C.

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Charles S. Fish  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 9/22/08 appealing from the Office action mailed 12/26/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. Appellant's brief presents arguments relating to the drawing objections. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5491912	SNABB	2-1996
3990159	BORGEAS	11-1976

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Drawings*** (Drawing objections are included in the Answer for the purpose of facilitating the Board's understanding of the issues in the rejection)

1. The drawings were received on 9/28/05. These drawings are not entered because they contain new matter, i.e. the thickness, shape, exact location, etc. of the midsole is considered to be new matter. In response applicants' arguments directed towards the new matter added to the drawings in order to show the midsole, it is noted that it is applicants' responsibility when originally filing the application to ensure that all claimed elements are clearly shown in the drawings, the addition of elements at a later date in most cases does add new matter and will not be entered.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the midsole(s) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to because the specification states that 824 is a point at  $\frac{1}{2}$  the length of the shoe, however the point at 824 in figure 14 appears to be clearly in the forefoot portion of the shoe, this is confusing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of

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any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5, and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Snabb (5491912).

First it is noted that the elected species was first disclosed in parent application 09/688308 filed 10/13/2000 and therefore the subject matter is only given the benefit date of 10/13/2000. Snabb shows a shoe with an upper, insole (24), and planar surfaced outsole (20, see figures 2 and 5 and the description of such) with the claimed shape (described in column 3 lines 41-50 and column 4 lines 35-40). In reference to the location shown and described by Snabb appears to be the same location shown in applicants' figure 14 and is considered to be "substantially halfway" as claimed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 14, 16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snabb.

Snabb shows a shoe substantially as claimed except for a plurality of midsoles located between the insole and outsole. Official notice is taken that the use of midsoles between insoles and outsole is extremely well known and conventional and since applicant has not shown such or provided any detail of such, it is assumed that applicant is claiming a well known and conventional midsole(s). It would have been obvious to provide a midsole(s) in the shoe of Snabb is well known and conventional to increase comfort and cushioning.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Snabb in view of Borgeas (3990159).

Snabb as discussed above shows a shoe with an insole substantially as claimed except for the insole being "removable". Official notice is taken that it is well known and conventional to allow insoles to be removable to allow orthotic inserts to be used, insoles and/or shoes to be laundered, to adjust worn elements, etc. In response to applicants' request, Borgeas has been applied as showing the well known and conventional practice of allowing inserts/insoles to be removable and replaceable. It would have been obvious to make the insole removable as is well known and conventional and taught/shown by Borgeas in the shoe of Snabb to provide any of the known benefits of removability as discussed above.

**(10) Response to Argument**

In response to applicants' arguments directed towards the drawing objections, most of these arguments have been addressed above. It is noted that the proposed drawing amendment filed 1/30/06 figure 14, applicant has not only added midsoles and moved the location of the number 824, but also changed the location where the first portion (820) and second portion (826) meet. This is considered to raise new matter also. The shape shown in figure 14 of the original drawings shows an insole with a shape in which the location of the meeting of the portions 820 and 826 is considered to be "approximately halfway" (emphasis added) as recited in the specification originally filed. It would be admissible if applicant were to file drawings in which only number 824 is moved to the location shown in originally filed drawings as the point where the portions 820 and 826 meet. Drawing deficiencies cannot be corrected by the addition of new matter. In response to applicants' arguments directed towards the well known and conventional rejection of the midsole and applicants' attempt to enter new matter into the drawings, the fact that an element is obvious and well known does not mean that it was appropriately disclosed in a specific application and that one is able to add such to the disclosure without the information being new matter.

In response to applicants' arguments directed towards Snabb, Snabb clearly states that an insole is the layer which has the structure as claimed, this is specifically discussed and clearly disclosed in Snabb in column 2 lines 15-45 and in column 3 lines 41-50 and column 4 lines 35-40. The toe portion of Snaab is stated as being 0 slope/uniform thickness forward of the ball 28 centers of pressure, not at 29 as argued.



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The reference to 29 merely refers to a general area that is uniform in thickness.

Furthermore it is noted that Snabb clearly states in column 4 lines 50-55 that the slope angle can be adjusted by placing inserts on the inner sole. In response to applicants' arguments directed towards the term "flat", it is noted that flat does not necessarily mean level, in fact Snabb clearly discusses the "flat reverse slope" in column 2 line 43. A flat surface can be at an angle.

In reference to applicants' arguments in reference to the placement of the change in slope being "at a point substantially halfway", the location shown as being near reference number 28 of Snaab is considered to be "substantially halfway" as shown by applicant in the original drawings.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.  
Respectfully submitted,

/Marie Patterson/  
Primary Examiner 3728  
9/29/08

Conferees:

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TQAS TC 3700